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Paper No. 8

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APR 08 2002

OFFICE OF PETITIONS

In re Application of :
William D. Brown :
Application No. 09/733,631 : **ON PETITION**
Filed: 7 December, 2000 :
Attorney Docket No. 23354/49C2 :

This is a decision on the petition under 37 CFR 1.137(b), filed on 12 March, 2002, to revive the above-identified application. This is also a decision on the petition filed on 12 March, 2002, requesting that the above-identified application be accorded a filing date of 8 December, 2000, with Pages 19 and 22 of the specification as a part of the original disclosure, which is treated as a petition under 37 CFR 1.53.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The petition under 37 CFR 1.182 is **DISMISSED**.

Petitioner is given **TWO MONTHS** to file a request for reconsideration (no further petition fee required). The failure to file a request for reconsideration within two months of the date of this decision (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the application as deposited in the PTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136(a) or (b).**

Petition Under 37 CFR 1.137(b)

The above-identified application became abandoned on 13 March, 2001, for failure to timely file the statutory basic filing fee and surcharge for its late filing as required by the Notice to File Missing Parts of Nonprovisional Application mailed on 12

January, 2001, which set a two (2) month period for reply. No extensions of time in accordance with 37 CFR 1.136(a) were obtained. The filing of the present petition precedes the mailing of Notice of Abandonment.

Petition Under 37 CFR 1.182

On 8 December, 2000, Application No. 09/733,631 was deposited as a continuation of Application No. 08/946,712, filed on 8 October, 1997, and which issued as U.S. Patent No. 6,168,744 on 2 January, 2001.

On 12 January, 2001, Initial Patent Examination Division mailed a Notice of to File Missing Parts of Nonprovisional Application, notifying petitioners that the application had been accorded a filing date but, *inter alia*, Pages 19 and 22 of the specification appeared to have been omitted from the application.

In response, on 12 March, 2002, the present petition was filed. Petitioners assert that Pages 19 and 22 of the specification were among the application papers deposited on 8 December, 2000. In support, petitioners state that a copy of their itemized postcard receipt, itemizing the filing of a "[c]opy of the prior patent application...as filed in parent." Petitioners request that the application, including Pages 19 and 22 of the specification, should be accorded a filing date of 8 December, 2000.

At the outset, it is noted that no copy of an itemized postcard receipt itemizing the filing of the application is located among the papers received with the petition on 12 March, 2002. Any renewed petition should include a copy of the postcard receipt. However, assuming, *arguendo*, that petitioners' supplied a date-stamped postcard receipt itemizing the filing of a "[c]opy of the prior patent application," such postcard does not properly itemize the specification with regard to the pages comprising the specification. The practice requires that any paper for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.¹ A postcard receipt will not serve as prima facie evidence of receipt in the USPTO of any items which are not properly itemized

¹See section 503, Manual of Patent Examining Procedure (MPEP 503).

and identified. Furthermore, an application transmittal letter is, at best, only evidence of what was intended to be filed, not evidence of what was actually received or filed in the USPTO.

Moreover, petitioners' assertion that Pages 19 and 22, which were omitted on filing and a part of a copending application mentioned on the application transmittal sheet are a part of the original disclosure, is not persuasive. A review of the record reveals that the specification, as filed, consists of Pages 1-18, 20, 21, and 23-36. The specification as filed, however, does not contain Pages 19 and 22. Clearly Pages 19 and 22 were intended to be a part of this application. Whether Pages 19 and 22 were a part of a copending application is not an issue here since the copending application was not specifically incorporated by reference into the disclosure of this application.² The mere reference to another application is not an incorporation of anything therein into the application containing the reference.³ To allow one to retroactively incorporate by reference a second application into a first application would allow the addition of matter into an application that was not present on filing which would be contrary to our statutes and rules. Still further, the question of new matter is not an issue here. Pages 19 and 22 were simply not filed in the USPTO on 8 December, 2000. Matter included in Pages 19 and 22 may be submitted as an amendment for consideration by the examiner under MPEP sections 608.02(p) and 608.04. In view of the above, the application cannot be accorded 8 December, 2000, as the application filing date with Pages 19 and 22 as a part of the original disclosure.

The application will be processed and examined using only the application papers present on 8 December, 2000. The copies of Pages 19 and 22 supplied with the present petition will not be used for processing or examination, but will be retained in the application file.

The declaration filed with the present petition on 12 March, 2002, which states that Ajay P. Malshe, Arzu M. Ozkan, and William D. Brown are joint inventors does not correctly recite the inventive entity. 37 CFR 1.41(a)(1) now defines the

²See MPEP 608.01(p). It is noted that the transmittal sheet contained an incorporation by reference paragraph with a box next to it to be checked if the paragraph is applicable. As the box next to the incorporation by reference paragraph is not checked, it is apparent that no incorporation by reference was intended.

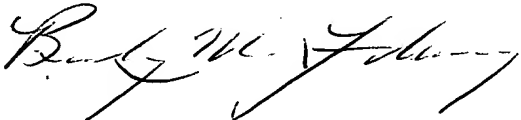
³See In re de Seversky, 177 USPQ 144, 146 (C.C.P.A. 1973); Dart Industries v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980).

inventorship of a non-provisional application as that inventorship set forth in the oath or declaration filed to comply with the requirements of 37 CFR 1.63. The declaration filed on 6 December, 2000, lists William D. Brown as the sole inventor. A petition under 37 CFR 1.48 is required to amend the inventive entity.

Receipt of the change of correspondence address filed on 12 March, 2002, is acknowledged.

The application is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of 8 December, 2000, using the application papers filed on that date.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood at (703)308-6918.



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